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### **REMARKS**

Responsive to the Office Action mailed June 16, 2006, Applicants provide the following. Claims 10 and 23 have been amended. Claims 33 and 34 have been added without adding new matter. Thirty-four (34) claims remain pending in the application: Claims 1-34. Reconsideration of claims 1-9, 11-22 and 24-32 in view of the remarks below and consideration of new claims 33 and 34 is respectfully requested.

Initially, Applicants acknowledge with appreciation the Examiner's willingness to take part in the telephonic interview on September 13, 2006. Applicants acknowledge with appreciation the Examiner's indication that claims 10 and 23 would be allowable if rewritten in independent form. Applicants note that this response is timely filed, Monday, September 18, 2006 being the first business day following the date set for reply, Saturday, September 16, 2006.

Claims fees are submitted herewith for two additional independent claims and for two additional claims in excess of 20 claims.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

### **Summary of Applicant Initiated Examiner Interview**

1. Per 37 CFR § 133(b), the following is a brief summary of the Examiner interview conducted September 13, 2006 via telephone between Scott J. Menghini and Casey R. Huffmire, Attorney of Record and law clerk, and Examiner Ingrid Wright and supervising Examiner Lynn Feild.

No exhibits were shown or demonstrations conducted. Independent

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claim 1 was discussed, though Applicants note that the discussion was pertinent to each of the independent claims, 1, 15 and 27. The prior art references that were discussed were U.S. Patent No. 6,259,597 to Anzai et al. and U.S. Patent No. 5,737,183 to Kobayashi et al.

The principal argument discussed during the interview was that claims 1-9, 11-22 and 24-32 are not rendered obvious under 35 U.S.C. §103(a). New dependent claims directed to the coupling portion comprising a clipping portion were proposed as allowable since they are directed to subject matter similar to allowable claims 10 and 23. It was additionally presented that claim 31 should be allowable like claims 10 and 23 since it was directed to clipping the cover to the electronic device, a feature clearly not taught by Anzai et al. It will be appreciated that the general nature or thrust of the principal arguments identified above can be understood in the context of the application file, including the arguments presented below. No agreement was reached.

#### Allowable Subject Matter

2. Claims 10 and 23 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicants hereby amend claims 10 and 23 in independent form including all of the limitations of their respective base and intervening claims. Accordingly, Applicants respectfully submit that claims 10 and 23 are in condition for allowance.

#### Claim Rejections - 35 U.S.C. §103

3. Claims 1, 5, 7-9 and 11-14 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,259,597 (Anzai et al.) in view of U.S. Patent No. 5,737,183 (Kobayashi et al.). This rejection is respectfully traversed and reconsideration is requested.

Claim 1 recites "a coupling portion adapted to removably couple the

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cover portion to the electronic device". It is acknowledged in the Office Action, and Applicants agree, that Anzai fails to teach that the coupling portion (22, 50) of Anzai removably couples its touch panel section to its electronic device (see page 3, the first full paragraph of the present office action). The Kobayashi patent is provided to show a removable cover for a computer device and it is asserted that it would have been obvious to modify the device of Anzai to include a coupling device that removably couples a cover to an electronic device. Applicants respectfully traverse and submit that claim 1 is not rendered obvious by the proposed combination of Anzai and Kobayashi because there is no proper motivation to modify Anzai with the teaching of Kobayashi (or any other reference that teaches a removable cover).

MPEP 2143.01(I) requires that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Anzai's electrical touch panel section 40 is rotatably supported by hinge mechanisms 22 to a portable electronic device, such as a notebook PC 10 (FIG. 1). Wiring lines 46A and 48A electrically couple the touch panel section 40 to the device via a touch panel control circuit 72 enabling the portable electronic device to receive electrical signals from the touch panel section 40 (col. 5, lines 3-9 and FIGS. 2 and 5). The touch panel section 40 allows the user to interact with the functionality of the portable electronic device, e.g., to function as a digitizer or tablet. Thus, the touch panel section 40 is mechanically, electrically and functionally integrated with the portable electronic device. There is no suggestion that the touch panel section 40 be removable in any way. In fact, the touch panel section 40 is specifically designed to be "accommodated in a space between the flat panel display and the keyboard when a user is to carry the portable electronic device" (see col. 2, lines 23-28).

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Kobayashi simply teaches using screws 11 to permit attaching and detaching a cover 3 to a portable computer 1 (col. 4, lines 39-44 and FIG. 4). Although Kobayashi suggests a cover that is mechanically removable, there is no suggestion in the prior art to modify Anzai to make the touch panel section 40 which is mechanically, electrically, and functionally integrated with the electronic device removable as the cover in Kobayashi is removable. Anzai has specifically designed the touch panel section to be accommodated between the display and the keyboard when not in use (see col. 2, lines 23-28 and col. 6, lines 8-10). The panel section 40 is also designed so as not to damage or limit the operation of the display screen or the keyboard in use (e.g., see col. 3, lines 33-40 and 46-55). That is, the touch panel section is designed to be a permanent part of the electronic device. It is inherent that allowing the touch panel section to be removable would make the touch panel section susceptible to being damaged or scratched (since it would not be protected between the display screen and the keyboard). Indeed, it is believed that if Anzai had intended the touch panel section 40 to be removable, Anzai would have included additional description and details to allow for such removability, but instead has gone to lengths to design the panel section to be integrated. Thus, due to the design and level of integration of the touch panel section 40 with the device, it is inherent in the device of Anzai that the touch panel section 40 is not removable and that Anzai teaches away from any suggestion to make it removable. Due to the level of integration (mechanically, electrically and functionally), it would be undesirable to make the touch panel section removable. In fact, the section 40 is designed to remain integrated, rather than be removable. Again, MPEP 2143.01 requires that the prior art suggest the desirability of the claimed invention. For example, one of ordinary skill in the art would not be motivated to modify Anzai in such a way because the utility of the touch panel device would be diminished. The touch panel section is mechanically, electrically and functionally integrated into the portable electronic device enabling a user to input data by interfacing with the touch

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panel section. The cover in Kobayashi, in contrast, is merely mechanically attached to the portable computer. Making the touch panel section in Anzai removable as taught by Kobayashi does not address the electrical and functional integration such that making it removable would destroy the electronic operability of the touch panel section by disabling the wire lines which carry data to the touch panel control circuit embedded in the portable electronic device.

Additionally, MPEP 2143.01(V) also states that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. A principal purpose of the Anzai invention is to have a touch-sensitive panel that is electrically connected via electrode terminals to a base unit, for example, a notebook personal computer. This purpose is frustrated if the touch panel section is removable because the wire lines (i.e. electrodes) which carry data from the touch panel section to the touch panel control circuit embedded in the base unit would be disconnected and not reconnectable.

Furthermore, according to MPEP 2143.01(III), the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In this case, even though it may be technologically possible to make the touch panel section 40 of Anzai removable, there is nevertheless no suggestion provided to suggest that the touch panel be removable or any suggestion of why this would be desirable. That is, it is inherent in the teaching of Anzai that the touch panel section is to be an integral and permanent portion of the electronic device.

For at least the aforementioned reasons, there is no motivation to modify Anzai in view of Kobayashi and; thus, a *prima facie* case of obviousness has not been made. Therefore, Applicants respectfully submit that the rejection of claim 1, and any claims dependent thereon, is overcome and should be withdrawn. Applicants

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respectfully submit that the rejection of claims 1, 5, 7-9 and 11-14 is overcome and should be withdrawn.

4. Claims 2-4, 15-18, 20-22 and 24-32 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Anzai in view of Kobayashi, further in view of U.S. Patent No. 5,204,160 (Rouser et al.).

Independent claims 15 and 27 both recite elements similar to those recited in claim 1. It has been shown above that claim 1 in view of the proposed combination of Anzai and Kobayashi. Thus, for reasons discussed above with respect to the rejection of claim 1, claims 15 and 27 are also not rendered obvious in view of Anzai with Kobayashi. The additional reference, Rouser, describes a light collimating film and provides no additional teaching to support modifying the touch panel section of Anzai to make it removable. Thus, Applicants respectfully submit that the rejection of claims 15 and 27, and any claims dependent thereon, is overcome and should be withdrawn. Therefore, Applicants respectfully submit that the rejection of claims 2-4, 15-18, 20-22 and 24-32 is overcome and should be withdrawn.

Furthermore, claim 31 recites a similar limitation as allowable claims 10 and 23, namely, claim 31 recites the limitation of "clipping the cover to the portion of the electronic device". Since, as noted in the Office action and as discussed in the telephone interview, this limitation is clearly not taught in the prior art of record, Applicants respectfully submit that the rejection of claim 31 is overcome for at least this reason and should be withdrawn.

5. Claims 6 and 19 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Anzai in view of Kobayashi, further in view of Rouser and U.S. Patent No. 5,982,617 (Haley et al.).

Dependent claims 6 and 19 depend from claims 1 and 15, respectively,

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which have which have been shown above not to be rendered obvious by the proposed combination of references. Therefore, Applicants respectfully submit that the rejection of claims 6 and 19 is overcome and should be withdrawn.

#### New Claims

6. Newly submitted claims 33 and 34 are believed to be allowable because they are directed to that which is not shown or suggested in the prior art. Furthermore, claims 33 and 34 are believed to be allowable because they recite a similar limitation to allowable claims 10 and 23, and claim 31 which is also believed to be allowable as discussed in the telephone interview.

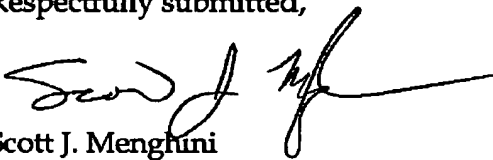
Support for new claims 33 and 34 can be found at least at page 10, lines 4-6 of the specification, FIGS. 7, 8 and 10 and claims 10 and 23.

#### CONCLUSION

Applicants submit that the above amendments and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

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